

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARRYL F. GARRIGUS

Appeal No. 1999-0810
Application No. 08/463,883

ON BRIEF

Before GARRIS, PAK, and KRATZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claim 23. The only other claims remaining in the application, which are claims 20 and 22, have been allowed by the examiner.

The subject matter on appeal relates to a sintering process for preparing a perovskite ceramic which comprises coating a substrate with a sol containing precursors of the

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perovskite ceramic, the sol being susceptible to heating by absorbing microwave energy, and exposing the coated substrate to microwave radiation to sinter the sol to a perovskite ceramic by heating. Further details of this appealed subject matter are set forth in the appealed claim which reads as follows:

23. A sintering process for preparing a perovskite ceramic, comprising the steps of:

(a) coating a substrate with a sol containing precursors of the perovskite ceramic, the sol being susceptible to heating by absorbing microwave radiation;

(b) exposing the coated substrate to microwave radiation for pulses of selected duration to sinter the sol to a perovskite ceramic by heating the coated substrate to a temperature above 800°F.

No references have been relied upon by the examiner in the rejection before us on this appeal.

Claim 23 stands rejected under the first paragraph of 35 U.S.C. § 112. It is the examiner's basic position that claim 23 does not comply with either the written description requirement or the enablement requirement of this paragraph because the claim is directed to a perovskite ceramic generically rather than to a LaMnO₃-family perovskite ceramic specifically. According to the examiner, "[t]he specification, as originally filed, does not provide an

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adequate written description of a method of microwave sintering a non-LaMnO₃ family ceramic [,and] [t]he specification does not enable one skilled in the art to make or use the invention commensurate in scope with these claims [sic]" (answer, page 3).

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and by the examiner concerning the above noted rejection.

OPINION

For the reasons which follow, we cannot sustain this rejection.

The examiner's burden of proof in questioning the enablement of an inventor's disclosure requires that the PTO advance acceptable reasoning inconsistent with enablement. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). In the case before us, the examiner has failed to carry this burden.

We are mindful of the examiner's point that the subject specification disclosure identifies the LaMnO₃-family ceramic specifically with respect to the appellant's microwave

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sintering method. However, as expressly noted by the appellant (e.g., see page 6 of the reply brief), an original disclosure on page 5 of the specification teaches "[t]he process is effective because the perovskite structure is a strong absorber of microwave energy so rapid heating occurs once the conversion begins." This teaching in combination with the specification disclosure concerning microwave sintering of LaMnO_3 -family ceramics specifically support the appellant's presumptively valid position that one having an ordinary level of skill in this art would be able to practice the here claimed sintering process for preparing a perovskite ceramic generically. On the other hand, the examiner has advanced no acceptable reasoning in support of his burden to show that the subject specification would not enable the ordinarily skilled artisan to practice the here claimed process. Indeed, the examiner has not given a single technical reason for believing that an attempt to practice this process would involve undue experimentation.

Under these circumstances, we cannot sustain the examiner's section 112, first paragraph, rejection of appealed claim 23 as being nonenabled.

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As for the written description issue raised by the examiner, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Moreover, the burden of showing that a claimed invention is not described in an application rests on the PTO in the first instance, and the PTO must give reasons why a description not in ipsis verbis is insufficient. In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978).

Again, we view the examiner as having failed to carry his burden of proof with respect to the written description issue before us on this appeal. This is because the examiner's basic position, in essence, is limited to an assertion that the appellant's original disclosure does not literally describe "non-LaMnO₃ family" ceramics which are embraced by the appealed claim. For example, on page 4 of the answer the examiner urges that,

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while the originally filed specification discussed LaMnO₃ family ceramics throughout the specification and provides the method of sintering LaMnO₃ family ceramics, it contains absolutely no statement of [sic, or] inference with regard to non-LaMnO₃ family ceramics [and that] [t]his clearly reflects that the appellant did not contemplate extending his sintering method to non-LaMnO₃ family ceramics at the time the present invention was made and filed.

As indicated earlier, however, the examiner's burden in a written description rejection is not carried simply by urging a lack of literal support for the claimed subject matter. Further, we question the accuracy of the examiner's above quoted assertion that the appellant's specification "contains absolutely no statement of [sic, or] inference with regard to non-LaMnO₃ family ceramics." In this regard, we reiterate the observation that specification page 5, in discussing the appellant's microwave sintering method, discloses that "[t]he process is effective because the perovskite structure is a strong absorber of microwave energy so rapid heating occurs once the conversion begins." It would seem reasonable to consider that this disclosure would convey to the artisan that the appellant had possession on the filing date of the now claimed sintering process for preparing a perovskite ceramic generically. Certainly, on the record of this appeal, the

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examiner has advanced no reason in support of a contrary view regarding this disclosure.

In light of the foregoing, we also cannot sustain the examiner's section 112, first paragraph, rejection of appealed claim 23 as lacking written description support.

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The decision of the examiner is reversed.

REVERSED

	Bradley R. Garriss)	
	Administrative Patent Judge)	
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)	
	Chung K. Pak)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Peter F. Kratz))
	Administrative Patent Judge)	

BRG:tdl

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